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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,311	06/07/2001	Maurice Ronan Goodman	7802-A08-002	8420
33771	7590	08/10/2009	EXAMINER	
PAUL D. BIANCO Fleit Gibbons Gutman Bongini & Bianco PL 21355 EAST DIXIE HIGHWAY SUITE 115 MIAMI, FL 33180			GOTTSCHALK, MARTIN A	
			ART UNIT	PAPER NUMBER
			3696	
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			08/10/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

<b>Application No.</b> 09/876,311	<b>Applicant(s)</b> GOODMAN ET AL.	
<b>Examiner</b> MARTIN A. GOTTSCHALK	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 28 May 2009.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-6 and 8-21 is/are pending in the application.  
4a) Of the above claim(s) 8-13 and 17-19 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) 1-6, 14-16, 20, and 21 are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Notice to Applicant*

1. Claims 1-6 and 8-21 are pending. Claim 7 is cancelled. Claims 20 and 21 are new. Claims 8-13 and 17-19 were withdrawn in response to a previous restriction requirement.
2. Claims 1-6, 14-16, and 20-21 were subject to a second restriction requirement mailed 01/16/2009. Applicant subsequently elected claims 1-6 and 14-16 (Group I) with traverse. The reasons for traversal are most recently presented in Applicant's response received 05/28/2009, to which this Office Action is responsive.

### *Election/Restriction*

3. In the traversal, Applicant has made several arguments that the Examiner finds non-persuasive. Applicant first asserts that restriction, on the basis that the inventions in Groups I and II are subcombinations usable together, is not proper apparently because the inventions recite overlapping claimed material. One example provided states that claim 1 of Group I recites "defining a plurality of...programme areas," while claim 20 of Group II recites "defining a measurable," which Applicant apparently feels are substantially the same. The Examiner respectfully disagrees, and responds that *prima facie*, a broad yet reasonable interpretation of these two terms could indicate to one of ordinary skill in the art materially different features.

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Applicant further asserts that both inventions include the feature of “allocating rewards.” In response, the Examiner points out that in fact, claim 1 of Group I is the only invention that explicitly requires this feature.

Applicant correctly notes that both inventions involve “rewarding points,” but the Examiner considers that in view of the scope of the inventions *in toto*, this commonality is not enough to demonstrate that the inventions are improperly restricted.

Furthermore, the Examiner notes that the invention of Group I could serve as a general program for collecting points and administering rewards based on unspecified parameters, the ultimate objective being to incentivize behavior that promotes compliance with a treatment regimen for a disease. This invention could be used in combination with the invention taught by claim 21 of Group II, where a smoker’s cotinine level is monitored to determine program compliance, so as to help motivate an individual addicted to cigarette smoking to quit. Likewise however, the latter could be used alone to gather information based on a patient’s smoking behavior.

Applicant notes that neither invention explicitly refers to addiction treatment. The Examiner concedes this point, but points out that this is only a suggested use of the claimed invention that would be understood by one of ordinary skill in the art, and is not required for restriction.

Applicant appears further to object to the suggested classification of the Group II invention into class 514, subclass 813 by noting that this classification refers to compositions for treating addiction, but fails to provide an alternative classification which Applicant feels to be more appropriate. The Examiner finds this point persuasive

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because the invention is not drawn strictly to a composition. An alternative classification is offered in this Office Action, and Applicant is afforded another opportunity to elect an invention based on this reclassification. The new classification will be in class 705, subclass 2. If Applicant cares to suggest an alternative deemed to be more appropriate, the Examiner would respectfully entertain such a suggestion.

Finally, with the next election, should Applicant traverse on the ground that the inventions are not patentably distinct because they are obvious variants, Applicant should submit additional evidence or identify such evidence now of record showing the inventions to be obvious variants, **or clearly admit on the record that this is the case.** In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Restriction to one of the following inventions is required under 35 U.S.C.

121:

I. Claims 1-6, and 14-16, drawn to a method for rewarding disease management programme participants based on their participation in health-related programmes, classified in class 705, subclass 14.

II. Claims 20 and 21, drawn to a method for rewarding disease management programme participants based on defined measurable performance parameters

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such as nicotine abstinence, classified in class 705, subclass 2.

5. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility as an incentive program and invention II has separate utility such as a method of treating tobacco addiction. See MPEP § 806.05(d).

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;

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- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

***Conclusion***

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARTIN A. GOTTSCHALK whose telephone number is (571)272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A. G./  
Examiner, Art Unit 3696

/Ella Colbert/  
Primary Examiner, Art Unit 3696